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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,530	01/16/2001	Mireille Maubru	05725.0828-00	2122
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER WANG, SHENGJUN	
			ART UNIT	PAPER NUMBER
			1617	
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			02/18/2009 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/759,530

Applicant(s)

MAUBRU ET AL.

Examiner

Shengjun Wang

Art Unit

1617

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-18, 23-34 and 37-44 is/are pending in the application.
- 4a) Of the above claim(s) 13, 15, 23-29 and 37-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12, 14, 16-18, 30-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notices of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Receipt applicants' amendments and remarks submitted November 12, 2008 is acknowledged.

Claim Rejections 35 U.S.C. 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-10, 12, 14, 16-18 and 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murray (US 5,720,964, of record), in view of Sweger et al. (US 5,482,704, of record), Babenko (US 6,277,893) and Saint-Leger (US 5,919,438, of record), and in further view of Harashima (EP 0268 982).

Murray teaches a conditioning shampoo composition (Murray, abstract). Murray's composition comprises

- A cosmetically acceptable aqueous medium (water; *id.* at 1: 49),
- anionic surfactant (such as sodium lauryl ether sulfate) and optionally nonionic or amphoteric surfactants (*id.* at 1: 48, 4: 66-67, 5:22-24),
- a cationic polymer (*id.* at 1: 57-59) such as polymer JR 400, or Jaguar C17 (*id.* at 4: 25-31), and

- An insoluble silicone obtained from an emulsion polymerized dimethylpolysiloxane microemulsions. Dimethiconol is preferred, which may be further capped with methyl group (*id.* at 1: 50-56, 5: 55-62; 6: 1-3).

Murray discloses exemplary compositions that also contain "Carbopol 980" (*id.* at 6: 7-30, Examples 2 and 3).

Murray does not teach expressly a composition comprise the amphoteric starches of Formulas I-IV and the other particular ingredients herein. .

However, Sweger teaches hair care compositions comprising the amphoteric starches of Formulas I and II (Sweger, abstract, 1:41-67). Sweger teaches that the amphoteric starches are thickeners and emulsion stabilizers (*id.* at 4: 29-33). Sweger compares lotion compositions containing an amphoteric starch (CEPA potato starch) with a control containing "thickener (Carbopol)" and secondary emulsifiers (*id.* at 8: 1-10; "Control 2" contained Carbopol 940 and the secondary emulsifiers "Ceteth 20" and "Glyceryl stearate SE"). Sweger discloses that experimental sample A, which contained amphoteric starch but no Carbopol or secondary emulsifiers, "is actually superior to the Carbopol standard (Control 2)" in maintaining viscosity of the lotion composition over time (*id.* at 8:48 to 9: 5). Furthermore, Sweger et al. teach the usefulness of the amphoteric starch herein employed in cosmetic composition. The starch derivatives may be used as thickener or emulsion stabilizer, they provide cosmetic composition with excellent aesthetic properties of skin feel and appearance. See, particularly, col. 1, line 20 to col. 2, line 33. The starch derivatives may be employed in various cosmetic compositions, including skin care creams and lotion, the cosmetic composition may comprise

various conventional cosmetic ingredients. The amounts of the starch derivatives employed are depending on the type of cosmetic compositions, but generally in the range of 0.1% to 20%. See, particularly, col. 4, line 39 to col. 6, line 40.

Babenko teaches the same amphoteric starches disclosed by Sweger (Babenko, 1: 60 to 2: 19) as useful in combination with dimethicone copolyol (*id.* at 2: 20-38) as an emulsifier for oil-in-water emulsions (*id.* At 2: 50-58), which are "widely used in cosmetic and dermatol[o]gical compositions or applications, particularly skin, hair and body care compositions" (*id.* at 1: 24-26). Babenko expressly suggests using the disclosed emulsion in shampoos (*id.* at 5: 20-23). Babenko further teaches particularly a stable oil-in-water emulsion for use in cosmetic composition comprising the starch derivatives herein as emulsifier. The emulsion is particularly useful in compositions such as creams, lotions, antiperspirants, make-up products, sunscreens, shampoos and body cleansing products. See, particularly, the abstract, column 5, lines 20-40. Dimethicone, a polydimethylsiloxane is particularly useful in making the emulsion. See, particularly, col. 6, 10-32.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the claimed invention was made to make a conditioning shampoo according to Murray (e.g., the Example #2 composition) that comprises all the ingredients of herein claimed composition except for the amphoteric starch and coconut monoisopropanolamide: cosmetically acceptable medium (water), washing base (the anionic surfactant, such as sodium lauryl ether sulphate), cationic polymer (Jaguar C17 or JR 400), and silicone (50% silicone emulsion polymer). (Murray 6: 6-30.)

3. Sweger and Babenko disclose the amphoteric starches of Formulas I and II. Sweger teaches that they are useful as thickeners and emulsifiers in hair care compositions, and Babenko teaches that an oil-in-water emulsion comprising the amphoteric starches and a silicone is useful in shampoos. Finally, Sweger teaches that the amphoteric starches are superior to Carbopol in providing a stable, thickened composition. Saint-Leger teaches that coconut monoisopropanolamide is particularly useful in shampoo composition, particularly with alkyl ether sulfate. See, particularly, the example 1, in col. 4. Further, none of the primary references require the present of fatty acid soap when amphoteric starch is used.

4. Based on the teachings of the cited references, a person of ordinary skill in the art would have considered it obvious to substitute the amphoteric starch disclosed by Sweger and Babenko for the Carbopol used in Murray's composition, e.g., Example #2 composition, because of the superior performance taught by Sweger. The resulting composition does not contain fatty acid soaps, and meets all the limitations of instant claim 1. The employment of coconut monoisopropanolamide would have been obvious because coconut monoisopropanolamide is an ingredient particularly known to be useful in shampoo composition. As to the newly added amendments, it is noted that the claim as amended recite silicone resins. Interpreted broadly, silicone resins would encompass the silicone gum disclosed by Murray et al. . Further, Murray et al. disclose that the dimethiconol may be further capped with methyl groups (i.e. with trimethylsilyl end group). Furthermore, the employment of different emulsion polymerized dimethylsilicone, such as those with trimethylsilyl end groups in the composition disclosed by Murray et al. would have been obvious to one of ordinary skill in the art as those emulsion

polymerized dimethylsilicone is similarly useful as dimethiconol. See, Harashima et al. particularly, table 7 at page 10.

Response to the Arguments

Applicants' amendments and remarks submitted November 12, 2008 have been fully considered, but are not persuasive.

5. The remarks as to the non-volatile polyorganosiloxane are not persuasive for reasons discussed above, particularly, it is noted that the claim as amended recite silicone resins. Interpreted broadly, silicone resins would encompass the silicone gum disclosed by Murray et al. . Further, Murray et al. disclose that the dimethiconol may be further capped with methyl groups (i.e. with trimethylsilyl end group). Furthermore, the employment of different emulsion polymerized dimethylsilicone, such as those with trimethylsilyl end groups in the composition disclosed by Murray et al. would have been obvious to one of ordinary skill in the art as those emulsion polymerized dimethylsilicone is similarly useful as dimethiconol. See, Harashima et al. particularly, table 7 at page 10.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching suggestion and motivation are found in the prior art and in the knowledge generally available to one of ordinary skill in the art. Particularly, the cited references

teaches each and every ingredients herein are known for the functions herein intended. The evidence of record shows that the subject matter as claimed is a combination of known components selected for their known properties. A claim which unites elements with no change in their respective functions to yield a predictable result is not patentable in the absence of secondary considerations.

For over a half century, the [Supreme] Court has held that a "patent for a combination which only unites old elements with no change in their respective functions ...obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men." Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147, 152 [87 USPQ 303] (1950). This is a principal reason for declining to allow patents for what is obvious. The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.

KSR Int'l v. Teleflex Inc., 82 USPQ2d 1385, 1395 (2007).

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Shengjun Wang/
Primary Examiner, Art Unit 1617